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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,366	06/26/2003	Ming-Hui Wei	CL001181DIV2	8350
25748	7590	11/21/2005	EXAMINER	
CELERA GENOMICS ATTN: WAYNE MONTGOMERY, VICE PRES, INTEL PROPERTY 45 WEST GUDE DRIVE C2-4#20 ROCKVILLE, MD 20850			PAK, YONG D	
			ART UNIT	PAPER NUMBER
			1652	
DATE MAILED: 11/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/606,366	WEI ET AL.	
	Examiner	Art Unit	
	Yong D. Pak	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/20/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-23 are pending and are subject to restriction.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2 and 20-21, drawn to a steroid oxidoreductase, classified in class 435, subclass 189.
- II. Claim 3, drawn to an antibody against the oxidoreductase of Invention I, classified in class 530, subclass 387.9.
- III. Claims 4-11 and 22-23, drawn to a polynucleotide encoding an oxidoreductase, host cell comprising said polynucleotide and a method of producing said oxidoreductase, classified in class 435, subclass 189.
- IV. Claim 12, drawn to a method for detecting presence of the polypeptide of Invention I, classified in class 435, subclass 25.
- V. Claim 13, drawn to a method of detecting presence of the polynucleotide of Invention III, classified class 435, subclass 6.
- VI. Claims 14-15, drawn to a method of identifying a compound which modulates to the polypeptide of Invention II, classified in class 514, subclass 789.
- VII. Claim 16, drawn to a method of identifying compounds that bind to the polypeptide of Invention I, classified in class 435, subclass 18.

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- VIII. Claim 17, drawn to a pharmaceutical composition comprising the agent produced in Invention VII, classified in class 514, subclass 789
- IX. Claims 18, drawn to a method of treatment with the agent of Invention VIII, classified in class 514, subclass 789.
- X. Claims 19, drawn to drawn to a method of identifying compounds that modulate the expression of the polypeptide of Invention I, classified in class 435, subclass 18.

The inventions are distinct, each from the other because of the following reasons:

The products of groups I-III and VIII are patentably distinct inventions because group I-II are drawn to polypeptides, group III is drawn to polynucleotides and group VIII is drawn to an agent, including inorganic or organic molecules.

The polynucleotide of group III and the polypeptide of group I are patentably distinct inventions for the following reasons. Polypeptides, which are composed of amino acids, and polynucleotides, which are composed of purine and pyrimidine units, are structurally distinct molecules; any relationship between a polynucleotide and polypeptide is dependent upon the information provided by the nucleic acid sequence open reading frame as it corresponds to the primary amino acid sequence of the encoded polypeptide. While a polypeptide of group I can be made by methods using some, but not all, of the polynucleotides that fall within the scope of group III, it can also be recovered from a natural source using biochemical means. For instance, the polypeptide can be isolated using affinity chromatography. For these reasons, the inventions of groups I and III are patentably distinct.

Furthermore, searching the inventions of groups I and III together would impose a serious search burden. In the instant case, the search of the polypeptides and the polynucleotides are not coextensive. The inventions of Groups I and III have a separate status in the art as shown by their different classifications. In cases such as this one where descriptive sequence information is provided, the sequences are searched in appropriate databases. There is search burden also in the non-patent literature. Prior to the concomitant isolation and expression of the sequence of interest there may be journal articles devoted solely to polypeptides which would not have described the polynucleotide. Searching, therefore is not coextensive.

The polypeptide of group I and the antibody of group II are patentably distinct for the following reasons:

While the inventions of both group I and group II are polypeptides, in this instance the polypeptide of group I is a single chain molecule that functions as an enzyme, whereas the polypeptide of group II encompasses antibodies. Thus the polypeptide of group I and the antibody of group II are structurally distinct molecules; any relationship between a polypeptide of group I and an antibody of group II is dependent upon the correlation between the scope of the polypeptides that the antibody binds and the scope of the antibodies that would be generated upon immunization with the polypeptide.

In this case, the polypeptide of group I is a large molecule which contains potentially hundreds of regions to which an antibody may bind, whereas the antibody of group II is defined in terms of its binding specificity to a small structure within SEQ ID

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NO: 2. Thus immunization with the polypeptides of group I would result in the production of antibodies outside the scope of group II.

Furthermore, searching the inventions of group I and group II would impose a serious search burden. The inventions have a separate status in the art as shown by their different classifications. A polypeptide and an antibody which binds to the polypeptide require different searches. An amino acid sequence search of the full-length protein is necessary for a determination of novelty and unobviousness of the protein. However, such a search is not required to identify the antibodies of group II. Furthermore, antibodies which bind to an epitope of a polypeptide of group II may be known even if a polypeptide of group I is novel. In addition, the technical literature search for the polypeptide of group I and the antibody of group II are not coextensive, e.g., antibodies may be characterized in the technical literature prior to discovery of or sequence of their binding target.

The polynucleotide of group III and the antibody of group II are patentably distinct for the following reasons. Polypeptides, such as the antibody of group II which are composed of amino acids, and polynucleotides, which are composed of nucleic acids, are structurally distinct molecules; any relationship between a polynucleotide and polypeptide is dependent upon the information provided by the nucleic acid sequence open reading frame as it corresponds to the primary amino acid sequence of the encoded polypeptide. In the present claims, a polynucleotide of group I will not encode an antibody of group II, and the antibody of group II cannot be encoded by a

polynucleotide of group III. Therefore the antibody and polynucleotide are patentably distinct.

The antibody and polynucleotide inventions have a separate status in the art as shown by their different classifications. Furthermore, searching the inventions of group II and group III would impose a serious search burden since a search of the polynucleotide of group III is would not be used to determine the patentability of an antibody of group II, and vice-versa.

Invention I and Inventions IV and VI-VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein of group I can be used for the production of antibodies against the protein. Searching the inventions of groups I, IV and VI-VII together would impose serious search burden. The inventions of groups I, IV and VI-VII have a separate status in the art as shown by their different classifications. Moreover, even if the polypeptide product were known, the methods of groups IV and VI-VI may be novel and unobvious in the view of the preamble or active steps.

Inventions III and Inventions V and X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially

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different process of using that product (MPEP § 806.05(h)). In the instant case the DNA of Invention III can be used for the production of the protein of group II or in hybridization assays. Searching groups I, V and X together would impose serious search burden. Groups I, V and X have a separate status in the art as shown by their different classifications. Moreover, even if the polynucleotide product were known, the method of groups V and X may be novel and unobvious in the view of the preamble or active steps.

Inventions IV-VII and IX-X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different function or different effects. (MPEP 806.04, 808.01). The instant specification does not disclose that these methods would be used together. The method of using a polypeptide and the method of using a polynucleotide are all unrelated as they comprise distinct steps and utilize different products which demonstrates that each method has a different mode of operation. Each invention performs this function using structurally and functionally divergent material. Therefore, the method of groups V and X and methods of groups IV and VI-VII are divergent in materials and steps. Further, the distinct steps and products require separate and distinct searches. As such, it would be burdensome to search groups IV-VII and IX-X together.

Inventions IV-VII and IX-X are unrelated because the specification does not disclose that these methods would be used together. The methods are divergent in

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steps and have different modes of operation. Each invention performs this function using structurally and functionally divergent material. Further, the distinct steps require separate and distinct searches. As such, it would be burdensome to search groups IV-VII and IX-X together.

Inventions V and X are unrelated because the specification does not disclose that these methods would be used together. The methods are divergent in steps and have different modes of operation. Each invention performs this function using structurally and functionally divergent material. Further, the distinct steps require separate and distinct searches. As such, it would be burdensome to search groups V and X together.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance

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with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

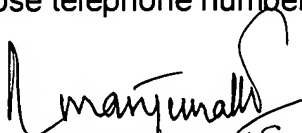
Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 571-272-0935. The examiner can normally be reached 6:30 A.M. to 5:00 P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Yong D. Pak
Patent Examiner 1652


Rao Manjunath
Primary Patent Examiner 1652